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In re Reexamination Proceeding No. :
90/006,250 :
For Patent No. 5,972,382 :
Issue Date: October 26, 1999 :
Attorney Docket No. 108064-00069 :

This is a decision on the petition filed February 4, 2004, which is being treated as a petition under 37 CFR 1.181 to review the decision of the Certificates of Correction Branch which refused, absent a petition under 37 CFR 1.183, to accept the correction of the assignee on the front page of the Reexamination Certificate published on March 4, 2003.

The petition is **dismissed**.

Petitioner requests issuance of a certificate of correction in the reexamination proceeding certificate in the names of "Sabinsa Corporation, Piscataway, NJ (US) and Sami Chemicals & Extracts (P) Ltd., Bangalore (IN)."

Petitioner states that he disagrees with the decision of the Certificates of Correction Branch mailed December 3, 2003 insofar as it requires a petition to correct the assignee data on the Reexamination Certificate, "because the assignment of an undivided one-half interest by Sabinsa Corporation to Sami Chemicals & Extracts (P) Ltd., Bangalore, India was recorded on September 6, 2000, after the patent had been issued and before the mailing of the Notice of Intent to Issue Reexamination Certificate." Petitioner further complains that "[t]he granting of the Reexamination Certificate did not involve any Issue Fee Transmittal that requires applicants to provide the correct names of the assignees."

Petitioner is correct in asserting that a petition under 37 CFR 1.183 to correct or change the assignee data is not the appropriate avenue of relief as there is no like provision for printing assignee data on the Reexamination Certificate as there is on a regular utility, design, or plant application. Unfortunately, petitioner is incorrect in assuming there is an error in the patent in not naming Sami as a co-assignee, much less that there is an error correctable by a Certificate of Correction.

The communication from the Certificates of Correction Branch erred in suggesting that a petition under 37 CFR 1.183 was required. Rather, that only applies when 37 CFR 3.81 was not complied with at the time the issue fee was remitted. See MPEP 1481. However, 37 CFR 3.81 requires that the assignment be already recorded, or submitted for recordation, at the time the issue fee is paid. That only can occur when the application is pending and the patent has not yet issued. In this regard, petitioner's attention is directed to 35 U.S.C. § 152, which states:

Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

Thus, the USPTO may issue a patent to the assignee of record of a pending application, or an assignee whose assignment was submitted for recordation against a pending application, at the USPTO. This statute, however, makes no provision for issuance of a patent to the assignee by way of an assignment recorded, or submitted for recordation **after** issuance of the patent as the application is then no longer pending but is an issued patent. That is, the statute does not authorize the USPTO to issue a patent to an assignee by way of an assignment that is recorded, or has been submitted for recordation, **after** the patent has issued. Likewise, this statute does not provide for a reexamination certificate to reflect that the previously issued patent in fact issued to an assignee not of record, or submitted for recordation at the time the patent issued. In other words, any change in the record assignee **after** issuance of the patent is immaterial as to whom the patent could have issued while it was pending.

The Reexamination Certificate is merely a document which reflects the status of all claims upon conclusion of the reexamination proceedings. See 35 U.S.C. § 307. A Reexamination proceeding is a proceeding applied to an issued patent, not to a pending application. See 35 U.S.C. § 305. There is no like provision in reexamination proceedings to either provide assignee data to be printed on the Reexamination Certificate or to request a correction or change to the assignee data. Further, as pointed out by petitioner herein, an assignment in the names of both of the assignees sought to be added on the Reexamination Certificate was submitted for recordation after the issuance of the original patent. Petitioner is reminded that an application may issue in the name(s) of the assignee(s) consistent with the application's assignment where a request for such issuance along with the processing fee is submitted after the date of payment of the issue fee, **but prior to issuance of the patent**, provided the assignment has been previously recorded or submitted for recording in the Office. If the assignment had been recorded or submitted for recordation **prior to issuance of the original patent**, and there was a discrepancy in the assignee's name between what was recorded or submitted for recordation, and what appeared on the as-printed

patent, then it would have been appropriate for issuance of a Certificate of Correction in the original patent as suggested by Certificates of Correction Branch. In view of the circumstances of this case, issuance of a Certificate of Correction would be improper and as such none will be forthcoming.

In other words, there is no error in the original patent in not reflecting the post-issuance conveyance of some of Sabinsa Corporation's rights in this patent to Sami Chemicals & Extracts. The reexamination proceeding did not, and could not, change this circumstance. There is simply no error correctable in this patent within the meaning of 35 U.S.C. § 254 or even § 255. A Certificate of Correction does not lie and will not be issued.

A copy of this decision is also being placed in the file of U.S. Patent No. 5,972,382, which is the patent subject of Reexamination Proceeding 90/006,250.

This file is being returned to the Files Repository.

Any questions concerning this matter may be directed to the undersigned at (703) 305-8680.



Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy